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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,314	08/08/2008	Namie Itoi	0445-0364PUS1	2570
2292 7590 11/28/2011 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER PHILIPS, BRADLEY H	
			ART UNIT 3764	PAPER NUMBER
			NOTIFICATION DATE 11/28/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/586,314	Applicant(s) ITOI ET AL.	
	Examiner BRADLEY PHILIPS	Art Unit 3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-12 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-12 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Applicant's arguments, see Election/Restriction, filed 08/15/2011, with respect to withdrawal of claim 6 as being directed to a non-elected species have been fully considered and are persuasive. The restriction of claim 6 has been withdrawn. Claim 6 as well as claims 1-12 will be examined in the following action.

Response to Amendment

With regard to the claim objection in the first action, examiner withdraws the objection to claim 8.

With regard to the claim rejection in the first action, examiner withdraws the rejection of claim 8 under 35 USC 112 2nd.

Examiner acknowledges claims 11 and 12 of applicant's amendments to the claims filed 08/15/2011 as having support in the specification.

An action on the merits of claims 1-12 of applicant's amendments filed 08/15/2011 follows.

Priority

Applicant's arguments, see Priority, filed 08/15/2011, with respect to foreign priority to application JP-017924 have been fully considered and are persuasive.

Acknowledgment is made of applicant's claim for priority under 35 U.S.C. § 119 e with reference to Application Number: JP-017924 filed on 1/27/2004.

Specification

With regard to the specification objection of the term "relative humidity" in the first action, examiner withdraws the objection. Applicant amendments to the specification traverse the objection.

Claim Objections

2. Claim 12 is objected to because of the following informalities: examiner suggests replacing "the absorbent cluster" with "the absorbent clusters." Appropriate correction is required.
- 3.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Dean (US 4822453 A; hereinafter "Dean".)

Regarding claim 1, Dean discloses an absorbent article having extensibility as a whole (Col. 21: 24-28, see abstract of incorporated reference US-3860003) and

comprising an extensible (col. 20: 59 – 62) absorbent member (Col. 21: 24 – 27) having a number of small absorbent clusters dispersed therein in three dimensions (Col. 20: 25 – 27.) Insofar as applicant discloses a small absorbent cluster containing a superabsorbent polymer and fibers, Dean discloses said cluster. Applicant admits that "tackiness of the superabsorbent polymer developed on wetting... whereby fibers stick to the superabsorbent polymer particles" results in small absorbent clusters [0022, 0023.] Therefore, examiner considers the wetted superabsorbent polymer as sticking to fibers of the absorbent structure of Dean (Col. 20: 25 – 27; Col. 59 - 62) thus resulting in small absorbent clusters.

Regarding claim 2, Dean discloses the absorbent article according to claim 1 as set forth above, wherein the absorbent member is stretchable (Col. 20: 59 - 62.)

Regarding claim 3, Dean discloses the absorbent article according to claim 1, wherein the absorbent member comprises a web containing crimped fibers, and the small absorbent clusters are dispersed in the web (col. 19: 45 - 50.)

Regarding claim 4, Dean discloses the absorbent article according to claim 1 as set forth above. Insofar as applicant discloses small clusters each composed of a superabsorbent polymer particle and a number of fibers adhered to the particle, Dean discloses said cluster. Applicant admits that "tackiness of the superabsorbent polymer developed on wetting... whereby fibers stick to the superabsorbent polymer particles" results in small absorbent clusters [0022, 0023.] Therefore, examiner considers the wetted superabsorbent polymer as sticking to fibers of the absorbent structure of Dean (Col. 20: 25 – 27; Col. 59 - 62) thus resulting in small absorbent clusters.

Regarding claim 5, Dean discloses the absorbent article according to claim 4. Insofar as applicant discloses forming small absorbent clusters, Dean discloses the formation of small absorbent clusters, as set forth above. Product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Hence, applicant's claim to small clusters obtained by mixing particles of the superabsorbent polymer and the fibers with water, drying the mixture, and grinding the dried mixture to size does not patentably distinguish over the prior art.

Regarding claim 6, Dean discloses an absorbent article having extensibility as a whole (Col. 21: 24-28, see abstract of incorporated reference US-3860003) and comprising an extensible (col. 20: 59 – 62) absorbent member (Col. 21: 24 – 27) having a number of small absorbent clusters dispersed therein in three dimensions (Col. 20: 25 – 27.) Dean additionally discloses a helically crimped fiber (Col. 12: 67 – 68, Col. 13: 1-5,) and other fiber (Col. 16: 15 -20, Col. 16: 1-5) in the absorbent member. Insofar as applicant discloses a small absorbent cluster containing a superabsorbent polymer and fibers, wherein the small clusters are each composed of a helically crimped fiber, a superabsorbent polymer particle, and other fiber, the polymer particle and the other fiber being taken into the helix of the helically crimped fiber Dean discloses said cluster.

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Applicant admits that "tackiness of the superabsorbent polymer developed on wetting... whereby fibers stick to the superabsorbent polymer particles" results in small absorbent clusters, "wherein fibers and the polymer particle are taken into the helix of the crimped fiber" [0022, 0023.] Therefore, examiner considers the wetted superabsorbent polymer as sticking to the helically crimped and other fibers of Dean (Col. 20: 25 – 27; Col. 59 - 62) thus resulting in small absorbent clusters, wherein the small clusters are each composed of a helically crimped fiber, a superabsorbent polymer particle, and other fiber, the polymer particle and the other fiber being taken into the helix of the helically crimped fiber. As a last note, Dean discloses that the other fiber is taken into the helix of the helically crimped fiber (col. 16: 27 – 31,) through applicant's process of "mechanical entanglement [0022, 23.]"

It is additionally noted that Dean describes a process of applicant's described "mechanical entanglement" [0022-0023] wherein Regarding claim 9, Dean discloses an absorbent article having extensibility (col. 20: 59 – 62; Col. 21: 24 – 27) Dean discloses all of the structural limitations of the present claims, and the absorbent of Dean is therefore fully capable of not being less absorbent when 150% extended in its longitudinal direction than before being extended.

Regarding claims 10 and 12, Dean discloses an absorbent article having extensibility as a whole (Col. 21: 24-28, see abstract of incorporated reference US-3860003) comprising an stretchable (col. 20: 59 – 62) absorbent member (Col. 21: 24 – 27) comprising a web containing crimped fiber (Col. 20: 25 – 27; Col. 12: 67 – 68, Col. 13: 1-5), the web having a number of small absorbent clusters dispersed in the web in

three dimensions (Col. 20: 25 – 27), the absorbent cluster containing a superabsorbent polymer particle and fibers. Insofar as applicant discloses a small absorbent cluster containing a superabsorbent polymer and fibers, Dean discloses said cluster. Applicant admits that "tackiness of the superabsorbent polymer developed on wetting... whereby fibers stick to the superabsorbent polymer particles" results in small absorbent clusters [0022, 0023.] Therefore, examiner considers the wetted superabsorbent polymer as sticking to fibers of the absorbent structure of Dean (Col. 20: 25 – 27; Col. 59 - 62) thus resulting in small absorbent clusters.

Regarding claim 11, Dean discloses the absorbent article according to claim 1 as set forth above, wherein the small absorbent clusters comprises hydrophilic fiber that is taken into a helical coil of a helically crimped fiber (Col. 4: 30 – 45.)

Claims 1, 2, 4, 5, 7, 8, and 9 rejected under 35 U.S.C. 102(e) as being anticipated by TSUCHIYA (EP 1142696 A1, hereinafter "Tsuchiya.")

Regarding claim 1, Tsuchiya teaches an absorbent article (title) having extensibility as a whole [0002]. Examiner considers diapers absorbent articles inherently extensible as a whole. For example, waist bands or leg elastics are inherent to diapers. Tsuchiya teaches an absorbent member having a number of small absorbent clusters dispersed therein in three dimensions (Fig. 7e, 15), the small absorbent clusters containing a superabsorbent polymer and fibers [Fig. 7; [0018 - 0020]]. The absorbent member of Tsuchiya teaches all of the structural limitations of claim 1, and is therefore fully capable of being extensible.

Regarding claim 2, Tsuchiya discloses the absorbent article according to claim 1. Tsuchiya discloses all of the structural limitations of claim 2, and is therefore fully capable of being stretchable.

Regarding claim 4, Tsuchiya discloses the absorbent article according to claim 1, wherein the small clusters are each composed of a superabsorbent polymer particle and a number of fibers adhered to the particle [0018-20.]

Regarding claim 5, Tsuchiya discloses the absorbent article according to claim 1 as set forth above. Product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Hence, applicant's claim to the small clusters are obtained by mixing particles of the superabsorbent polymer and the fibers with water, drying the mixture, and grinding the dried mixture to size does not patentably distinguish over the prior art.

Regarding claim 7, Tsuchiya teaches an absorbent article according to claim 1, wherein the small clusters have an average size of 0.2 to 5 mm [0020.]

Regarding claim 8, Tsuchiya teaches a water-absorbent composite comprising polymer particles immobilized on a fibrous substrate [0018], having a number of small absorbent clusters dispersed therein in three dimensions (Fig. 7e, 15), not shown to be

materially different from applicant's disclosed absorbent core. Because the absorbent article of Tsuchiya is not materially different from the absorbent article of the applicant, Tsuchiya encompasses an absorbent article according to claim 1 as set forth above, wherein the extensibility of the absorbent article is such that, when the absorbent article is 150% extended in its longitudinal direction, maintained in the extended state for 2 hours at 40.degree. C. and 80% RH, and released from the extended state, the lengths of the absorbent article measured after 20 seconds and after 5 minutes from the release are from 100% to 130%, respectively, of the initial length.

Regarding claim 9, Tsuchiya teaches a water-absorbent composite comprising polymer particles immobilized on a fibrous substrate [0018], having a number of small absorbent clusters dispersed therein in three dimensions (Fig. 7e, 15), not shown to be materially different from applicant's disclosed absorbent core. Because the absorbent article of Tsuchiya is not materially different from the absorbent article of the applicant, Tsuchiya encompasses an absorbent article having extensibility as set forth above and designed not to be less absorbent when 150% extended in its longitudinal direction than before being extended.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dean.

Regarding claim 8, when the structure recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent. Therefore, Dean discloses the absorbent article according to claim 1, wherein the extensibility of the absorbent article is such that, when the absorbent article is 150% extended in its longitudinal direction, maintained in the extended state for 2 hours at 40.degree. C. and 80% relative humidity, and released from the extended state, the lengths of the absorbent article measured after 20 seconds and after 5 minutes from the release are from 130% to 150% and from 100% to 130%, respectively, of the initial length. Dean additionally discloses A prima facie case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim except for a property or function and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, a rejection based alternatively on either section 102 or 103 of the statute is fair and acceptable. Once the examiner provides a rationale tending to show that the claimed article appears to be the same of similar to that of the prior art, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the prior art and the claimed product. In the present case, the reference has met the structural requirements of the claims.

Response to Arguments

5. Applicant's arguments with respect to claims 1-5, 7, and 10 rejected in view of Baker have been considered but are moot in view of the new ground(s) of rejection.

6. Applicant's arguments filed 08/15/2011 have been fully considered but they are not persuasive. Applicant claims Tsuchiya fails to disclose the claimed small absorbent cluster. However, as set forth in the rejection above, Tsuchiya discloses the claimed small absorbent cluster [0018 – 0020].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRADLEY PHILIPS whose telephone number is (571)270-5180. The examiner can normally be reached on Monday - Friday, approximately 8AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LoAn Thanh can be reached on (571)272-4966. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRADLEY H PHILIPS/
Examiner, Art Unit 3764

/LoAn H. Thanh/
Supervisory Patent Examiner, Art Unit 3764